

## REMARKS

Claims 34-39 and 50-58 are presently pending and under consideration in the above-captioned application.

### Allowable Claims

Applicant gratefully notes that the Examiner has deemed claims 34-39 and 50-57 to be allowable. Further, Applicant thanks the Examiner for his consideration of the amendments to the specification presented by way of the Amendment submitted on August 27, 2003, and for the Examiner's acknowledgement that those amendments did not constitute new matter.

### Summary of Telephone Interview with the Examiner

Applicant appreciates the courtesy shown his representative, Thomas Sossong, during the telephone conversation with the Examiner on December 31, 2003. In that conversation, the outstanding Double Patenting rejection of claim 58 was discussed. The Examiner has requested that Applicant's traversal of the Double Patenting rejection be presented in writing as a response to the Final Office Action.

The Examiner has kindly offered to call Applicant's representatives should the Examiner not be persuaded by the arguments set forth below in response to the Examiner's Double Patenting rejection of claim 58. Applicant appreciates the Examiner's offer to contact his representatives prior to issuing an Advisory Action, if such action is necessary.

### Double Patenting Rejection

The Examiner has rejected claim 58 under the judicially created doctrine of obviousness-type double patenting. Specifically, it is the Examiner's view that claim 58 is not patentably distinct from claim 2, subpart (d), of U.S. Patent No. 5,705,367 of Gotschlich. Applicant respectfully traverses the Examiner's rejection for the reasons set forth below.

The Examiner's double patenting rejection is based on "claim 2(d)" of the '367 patent. Applicant respectfully submits that the double patenting rejection is improper. Claim 2 of the '367 patent must be considered as a whole, because "claim 2(d)" does not exist as a separate entity. Subsection (d) of claim 2 is an essential part of a multi-step process claimed as a single method of preparing an oligosaccharide, which method comprises "**sequentially performing the steps of**" subsections (a) through (d).

Applicant respectfully points out that the controlling law in this situation is set forth in *General Foods Corp. v. Studiengesellschaft Kohle mbH* (972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992)), which holds that a subsection of a claim is not in and of itself "claimed," nor is that claim subsection "patented or covered." A claim must be considered as a whole for purposes of analysis in obviousness-type double patenting. Claim 2 *as a whole* is not the same as present claim 58. Rather, present claim 58 does not require the extra method steps required for claim 2 *as a whole*, and should therefore be considered patentably distinct.

The CAFC in *General Foods v. Studiengesellschaft* further stated that "the law of double patenting is concerned only with what patents claim." Therefore, anything less than the four-step process recited in claim 2 of the '367 patent is not what is claimed. For example, the practice of only *one* of the four steps of claim 2 of the '367 patent is not the practice of claim 2. In fact, the practice of only one of the four steps of claim 2 of the '367 patent is broader than claim 2 *as a whole*.

Accordingly, Applicant respectfully submits that the Examiner's double patenting rejection of claim 58 is improper, and requests that the Examiner reconsider and withdraw his rejection.

Summary

Applicant respectfully submits that the Examiner's rejection has been either overcome or rendered moot, and that each of claims 34-39 and 50-58 is fully supported by the specification as originally filed and in condition for allowance. Consideration and allowance of each of these claims are respectfully requested at the earliest possible date.

Respectfully submitted,  
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(Date)

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